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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,463	03/27/2001	William Skiles	SKILES 00.01	1833

7590

11/20/2002

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EXAMINER

RODRIGUEZ, RUTH C

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/818,463	Applicant(s) SKILES, WILLIAM	
	Examiner Ruth C. Rodriguez	Art Unit 3677	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 August 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30 and 31 is/are allowed.
- 6) ☒ Claim(s) 17-19 and 23-26 is/are rejected.
- 7) ☒ Claim(s) 20-22 and 27-29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 23 August 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Priority***

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

### ***Claim Objections***

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 34 been renumbered 31.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Willner (US 3,693,376).

A jewelry clasp (10) for releaseably holding an ornamental object (16) comprises a first fixture (14), a second fixture (14) and a spring member (12). The first fixture comprises a first convexoconcave structure having a first inner concave surface (22), a first outer convex surface and a first edge (20) continuously joining the first inner concave surface to the first outer convex surface (Figs. 1-4). The second fixture comprises a second convexoconcave structure having a second inner concave surface (22), a second outer convex surface and a second edge (20) continuously joining the second inner concave surface to the second outer convex surface (Figs. 1-4). The spring member has a first end (18) and a second end (18) where the first end is affixed to the first outer convex surface of the first fixture and the second end is affixed to the second outer convex surface of the second fixture (Figs. 1-3).

The member disclosed by Willner has a semicircular shape (Fig. 1-3).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 18 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willner in view of Darling (US 3,693,376).

Willner discloses a clasp having all the limitations listed above for the rejection of claim 5 above. However, Darling teaches the use of buoyant putty (cellular material) for jewelry (C. 1, L. 26-39). The putty will prevent the piece of jewelry from sinking when immerse in water (C. 2, L. 5-13). Darling also teaches that the buoyant putty also protects objects being hold with the putty against damage (C. 10, L. 33-39). Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have a first cellular material disposed on the first inner surface of the first fixture and a second cellular material disposed on the second inner surface of the second fixture according to the teachings of Darling in the device of Willner. Doing so, will prevent the object being held from becoming damaged and will also provide buoyancy to the piece of jewelry if it were to become immerse in water.

#### ***Allowable Subject Matter***

7. Claims 30 and 31 allowed.
8. Claims 20-22 and 27-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

9. Applicant's arguments filed 23 August 2002 have been fully considered but they are not persuasive.

10. The first argument present by the Applicant is that Willner fails to first and second convexoconcave structure. The Examiner fails to be persuaded by this argument.

Although Willner does not recite that the shape of the fixture is convexoconcave, the outer surface (all the exterior surface of the fixture element) of each of the fixtures does have a convex shape while the inner surface has an inner shape. Therefore, Willner does disclose a convexoconcave structure.

11. The Applicant also argues that the spring member disclosed by Willner is not affixed to the outer convex surface. Once again, the Examiner does not agree with this argument. The distal end of the outer convex surface is still part of the outer convex surface. Therefore, Willner does affix the spring member to the outer convex surface of the fixture. The amount of pressure exerted by spring onto the fixtures is not addressed in the claims therefore the arguments presented based on whether the location present by the applicant is better than the location disclosed by Willner does not have any relevancy with the respect to the claim subject matter.

12. Applicant's arguments with respect to claims 18 and 23-26 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wecht (US 1,251,308), Kirshner (US 3,014,298), Johnson (US 4,195,492), Milawski (US 4,625,526), Santiago (US 5,433,090), Guio (US 5,440,791), Hanson (US 5,946,943) and German Patent Document DE 31 04 396 A1 are cited to show state of the art with respect to the use of clasps or clips having some of the features claimed under the current application. Miller (US 3,896,527) and Willoughby (US 4,536,924) are cited to show state of the art with respect to the use of a ratchet system to urge two sides of a clamp together.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (703) 308-1881. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (703) 306-4115.

Submissions of your responses by facsimile transmission are encouraged. Technology center 3600's facsimile number for before final communications is (703) 872-9326. Technology center 3600's facsimile number for after final communications is (703) 872-9327.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Ruth C. Rodriguez  
Patent Examiner  
Art Unit 3677

*RCR*  
rcr

November 15, 2002



J. J. SWANN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600